

## **REMARKS**

### **Formal Matters**

Claims 1,5-22,25-33,40-54,58-91,96-97,100-107,225,229-255,282 and 284-300 are pending.

Claims 1,5-22,25-33,40-54,58-91,96-98,100-107,225,229-255,282 and 284-300 were examined.

Claims 1,5-22,25-33,40-54,58-91,96-98,100-107,225,229-255,282 and 284- were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks put forth in the amendment file December 7, 2005 and the supplemental remarks made herein.

No new matter has been added.

### **Remarks**

During a telephone conversation between the Examiner and Applicants' representative, the Examiner informed Applicants' representative that the rejection of claims 1, 9, 43-45, 106, 298 and 299 under 35 U.S.C. Section 102(b) as being clearly anticipated by Roth et al., relies upon Roth et al., U.S. Patent No. 5,207,672, and not Roth et al., U.S. Patent No. 5,823,956, as was assumed in Applicants' amendment filed on December 7, 2005. Accordingly, the remarks that follow are addressed to the rejection of claims 1, 9, 43-45, 106, 298 and 299 under 35 U.S.C. Section 102(b) as being clearly anticipated by Roth et al., U.S. Patent No. 5,207,672.

In rejecting the claims, the Examiner referred to Figures 1-7 and column 8, line 6 to column 17, line 15 as support for the assertion of anticipation. Upon reviewing the portions of Roth et al. identified, Applicants note that Figs. 1-7 are directed primarily to the use of a laser-powered instrument for treating the prostatic urethra to enlarge the passageway therethrough to facilitate normal urination in a patient. Laser energy is applied to a portion of the urethra to cause coagulation necrosis in some of the tissue. As the tissue heals, the necrotic tissue slough off, thereby enlarging the passageway in the prostatic urinary tract. Roth et al. notes at column 14, lines 58-60, that the rate of pull of the probe can vary and is a function of the laser energy exposure, and specifically must be at a rate so as to insure that the tissue does not explode due to the popcorn effect, carbonize or ablate. Accordingly, it is respectfully submitted that Roth et al. does not anticipate the present claims, as Roth et al. specifically teaches against ablating.

Further, with regard to claim 1, it can be seen in Fig. 11B of Roth et al. that the laser treatment is not transmural, since the areas 200 in which tissue is necrosed are shown as terminating well before the

outer wall of the urethra 172. With regard to claim 106, Roth et al. specifically teaches against delivery sufficient energy to ablate tissue, as noted above.

Claims 9, 43-45, 298 and 299 each depend from claim 1 and it is respectfully submitted that these claims are therefore allowable over Roth et al. for at least the same reasons provided above with regard to claim 1.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1, 9, 43-45, 106, 298 and 299 under 35 U.S.C. Section 102(b) as being clearly anticipated by Roth et al., U.S. Patent No. 5,207,672, as being inappropriate.

### **Conclusion**

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-117.

Respectfully submitted,

LAW OFFICE OF ALAN W. CANNON

Date: \_\_\_\_\_

12/22/05

By: \_\_\_\_\_



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